

**SUPPORT FOR THE AMENDMENTS**

Claim 42 is amended to delete the term "derivative".

It is respectfully submitted that there is no possibility of new matter and entry is respectfully requested.

### **REMARKS/ARGUMENTS**

Claims 39 - 54 are in the case.

The present claims are directed to a process for hydrogenating unsaturated organic compounds with hydrogen in the presence of a catalyst which comprises a catalytically active Group VIII metal(s) disposed on a support. At least one of the catalytically active Group VIII metal sites is required to have been obtained via the partial decomposition on the support of a complex of the metal and a compound selected from amino acids and compounds containing amino groups and hydroxyl groups. Furthermore, the partial decomposition is required to be such that the complex exhibits a new infra-red vibration band between 2100 and 2200  $\text{cm}^{-1}$ .

The claims have been rejected under 35 USC §112, second paragraph, because of the use of the terms "including", "containing" and "derivative".

Regarding "derivative", Applicant's have amended the claims to avoid use of the term where it lacks antecedent basis.

Use of the terms "including" and "containing" take their traditional meaning as leaving the claim open to the addition of other ingredients and/or other steps. Their use is explicitly sanctioned in MPEP 2111.03 and decades upon decades of case law. Their meaning cannot be clearer. We fail to understand the rejection and if the Examiner maintains the rejection further explanation is requested.

The rejection under 35 USC §103 appears to have been withdrawn.

It is unclear whether or not there also remains a rejection under 35 USC §112, first paragraph.

As previously stated in one or more responses, there is a plethora of prior art including the prior art of record in the case, e.g., Brunner et al, U.S. 6,284,917; Sugier et al, U.S. 3,761,428; and Scott, U.S. 2,889,287, teaching processes for hydrogenation of organic compounds using catalysts prepared by techniques that involve use of either an amino acid or an amino alcohol compound to form a metal complex on a support. However, in each prior art document the metal complex is fully decomposed (with the possible exception of D4,

where the catalyst is either fully decomposed or, in certain teachings, not decomposed at all). Note that the D1 referred to by the PCT examining authority, teaches hydrogenation of carbon monoxide, not hydrogenation of organic compounds.

Accordingly, the present claims are directed to a process that differ notably by the distinction between partial and fully decomposed complex, but otherwise within the skill of the "ordinary" artisan as described by the Examiner in the Official Action of September 3, 2008, to carry out.

Also as previously stated, Applicants disagree with the specific description of the level of skill in the art. Applicants respectfully assert that the ordinary artisan in this field would have a PhD and many years of experience, and would have one or more "BS Chemists" working for him or her to carry out "routine experimentation".

This has not been refuted by the Examiner.

As evidenced by the art of record, and for other reasons of record, such as previous responses by Applicant, the art of hydrogenation is NOT so unpredictable that, once given an explanation of the difference between the prior art - such as set forth in previous responses and in the present specification - and a new way of doing things, i.e., as set forth in the present specification - one of ordinary skill in the art - a PhD chemist with many years experience and having one or more BS chemists working for him or her - can practice the invention without undue experimentation. "Undue experimentation" is not necessarily limited by the time it takes.

In addition, once a catalyst system is shown to hydrogenate unsaturated organic compounds, generally the catalyst system in all its variants will hydrogenate most if not all unsaturated organic compounds, and furthermore Applicants respectfully note that the law has never been such that all possible species encompassed by a claim be enabled nor even that all possible variations actually work on every conceivable species.

This has also not been refuted by the Examiner

In view of the above arguments, especially the numerous references of record indicating that hydrogenation of unsaturated organic compounds using support Group VIII compounds is entirely routine *per se*, and the relatively narrow scope of the amended claims presented *supra*, Applicants respectfully request the withdrawal of the rejection under 35 USC §112, first paragraph.

For the above reasons, it is believed that the present invention is now in condition for allowance and early notice to this effect is earnestly solicited.

Respectfully submitted,

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Date

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